



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,968	12/06/2000	Mourad Ben Ayed		6993

7590 02/23/2004
Daniel B. Schein
P.O. Box 28403
San Jose, CA 95159

EXAMINER

ANYASO, UCHENDU O

ART UNIT	PAPER NUMBER
----------	--------------

2675

22

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,968

Applicant(s)

BEN AYED, MOURAD

Examiner

Uchendu O Anyaso

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 9-15 and 19-27** are pending in this action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claim 23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 23 includes the feature of “establishing a two-way wireless connection with a second device”. This feature was not described in the specification at the time the application was filed in such a way as to convey to one skilled in the relevant art that the inventor had possession of the claimed invention.

Claim Rejections - 35 USC ' 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 9, 12-15, 19-22, 24 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fujiwara* (U.S. Patent 5,301,222) in view of *Brooks* (U.S. 5,434,371).

Regarding **independent claims 9 and 22**, and for **claims 24 and 27**, *Fujiwara* teaches a portable radio telephone set comprising a main body 1 of a pencil shape that establishes a two-way connection between a calling party and a called party (column 2, lines 19-29, figure 1 at 1; column 1, lines 15-24).

Furthermore, *Fujiwara* teaches memory means in the form of a pattern ROM 32 for storing patterns of numerical and alphabetic letters, a program ROM 33 for storing a program by which a telephone number signal and a station name signal of the called party are generated, and a RAM 34 for storing the telephone number of a called party and a station name corresponding to the telephone number in the form of pattern signals (column 2, lines 46-58, figure 3 at 32-34).

Also, *Fujiwara* teaches a processor means in the form of CPU 31 which facilitates comparing the acceleration sequences generated by the information input unit 2 by receiving pulses generated by the ball 11 of the information input unit 2, these pulses are then stored in RAM 34 to provide a pattern of a letter wherein this pattern is compared to a set of patterns previously stored in the pattern ROM 32 before they are displayed on LCD 3 (column 3, lines 5-33).

Furthermore, *Fujiwara* teaches a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39).

Art Unit: 2675

Furthermore, Fujiwara teaches an information input unit 2 which comprising a ball 11 rotating in an arbitrary direction, encoders 12 and 13, and photo-interruptors 24 and 25 for generating signals indicative of moving distances of the ball 11 in the X-and Y-directions by cooperation with the gears 18 and 19, respectively (column 2, lines 30-40, figure 2 at 2, 11-19).

However, Fujiwara does not teach an accelerometer. On the other hand, Brooks teaches an acceleration sensor 20 within a system for creating artful expressions, including handwritten messages, drawings and other dexterously produced forms which comprises a marking implement having a self contained means of recording the creation wherein the writing implement comprises (column 1, lines 53-61; column 3, lines 30-43, figures 1-3 at 20).

Thus, it would have been obvious to a person of ordinary skill in the art to combine Fujiwara and Brooks because while Fujiwara teaches a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39), Brooks teaches how an acceleration sensor would be included in such a device. The motivation for combining these inventions would have been to design a pen system having accelerometers thereon to monitor the movement of the tip of the pen (column 3, lines 38-43, figure 3 at 20).

Regarding **claims 12 and 13**, in further discussion of claim 9, Fujiwara teaches a ball 11 which serves to activate the portable radiotelephone device (column 3, lines 526, figure 3 at 11).

Regarding **claims 14**, in further discussion of claim 12, Brooks teaches an acceleration sensor 20 within a system for creating artful expressions, including handwritten messages,

drawings and other dexterously produced forms which comprises a marking implement having a self contained means of recording the creation wherein the writing implement comprises (column 1, lines 53-61; column 3, lines 30-43, figures 1-3 at 20).

Regarding **claims 15**, in further discussion of claim 12, Fujiwara teaches a processor means in the form of CPU 31 which facilitates comparing the acceleration sequences generated by the information input unit 2 by receiving pulses generated by the ball 11 of the information input unit 2, these pulses are then stored in RAM 34 to provide a pattern of a letter wherein this pattern is compared to a set of patterns previously stored in the pattern ROM 32 before they are displayed on LCD 3 (column 3, lines 5-33).

Regarding **claims 19-21**, in further discussion of claim 9, Brooks teaches an acceleration sensor 20 within a system for creating artful expressions, including handwritten messages, drawings and other dexterously produced forms which comprises a marking implement having a self contained means of recording the creation wherein the writing implement comprises (column 1, lines 53-61; column 3, lines 30-43, figures 1-3 at 20).

Furthermore, Fujiwara teaches a memory means in the form of a pattern ROM 32 for storing patterns of numerical and alphabetic letters, a program ROM 33 for storing a program by which a telephone number signal and a station name signal of the called party are generated, and a RAM 34 for storing the telephone number of a called party and a station name corresponding to the telephone number in the form of pattern signals (column 2, lines 46-58, figure 3 at 32-34).

6. **Claims 10, 11, 23, 25 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Fujiwara* (U.S. Patent 5,301,222) in view of *Brooks* (U.S. 5,434,371), as in claim 9 above, and further in view of *Lapstun et al* (U.S. 6,474,888).

Regarding **claims 10, 11, 25 and 26**, in further discussion of claim 9, *Fujiwara* and *Brooks* do not teach explicitly bluetooth specification within his device. On the other hand, *Lapstun* teaches a pen including a marking device operative to mark a visible path onto a surface, the marking device being electronically controllable to change at least one attribute of the path, the pen including a user interface whereby a user may modify the at least one attribute, and at least one sensor device capable of sensing images including coded data (column 20, lines 40-45) wherein bluetooth technology would be employed within a pen device (column 20, lines 3-10).

Thus, it would have obvious to combine *Fujiwara*, *Brooks* and *Lapstun*'s inventions because while the combination of *Fujiwara* and *Brooks* teach a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39) wherein a processor means in the form of CPU 31 facilitates comparing the acceleration sequences generated by the information input unit 2 by receiving pulses generated by the ball 11 of the information input unit 2, such that the pulses stored in RAM 34 to provide a pattern of a letter wherein this pattern is compared to a set of patterns previously stored in the pattern ROM 32 before they are displayed on LCD 3 (column 3, lines 5-33), *Lapstun* teaches how a pen device would employ bluetooth

Art Unit: 2675

technology (column 20, lines 3-10). The motivation for combining these inventions would have been to provide an efficient communication form for the pen device (column 20, lines 3-10).

Regarding **independent claim 23**, Fujiwara teaches a portable radio telephone set comprising a main body 1 of a pencil shape that establishes a two-way connection between a calling party and a called party (column 2, lines 19-29, figure 1 at 1; column 1, lines 15-24).

Furthermore, Fujiwara teaches memory means in the form of a pattern ROM 32 for storing patterns of numerical and alphabetic letters, a program ROM 33 for storing a program by which a telephone number signal and a station name signal of the called party are generated, and a RAM 34 for storing the telephone number of a called party and a station name corresponding to the telephone number in the form of pattern signals (column 2, lines 46-58, figure 3 at 32-34).

Also, Fujiwara teaches a processor means in the form of CPU 31 which facilitates comparing the acceleration sequences generated by the information input unit 2 by receiving pulses generated by the ball 11 of the information input unit 2, these pulses are then stored in RAM 34 to provide a pattern of a letter wherein this pattern is compared to a set of patterns previously stored in the pattern ROM 32 before they are displayed on LCD 3 (column 3, lines 5-33).

Furthermore, Fujiwara teaches a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39).

Furthermore, Fujiwara teaches an information input unit 2 which comprising a ball 11 rotating in an arbitrary direction, encoders 12 and 13, and photo-interruptors 24 and 25 for generating signals indicative of moving distances of the ball 11 in the X-and Y-directions by cooperation with the gears 18 and 19, respectively (column 2, lines 30-40, figure 2 at 2, 11-19).

However, Fujiwara does not teach an accelerometer. On the other hand, Brooks teaches an acceleration sensor 20 within a system for creating artful expressions, including handwritten messages, drawings and other dexterously produced forms which comprises a marking implement having a self contained means of recording the creation wherein the writing implement comprises (column 1, lines 53-61; column 3, lines 30-43, figures 1-3 at 20).

Thus, it would have been obvious to a person of ordinary skill in the art to combine Fujiwara and Brooks because while Fujiwara teaches a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39), Brooks teaches how an acceleration sensor would be included in such a device. The motivation for combining these inventions would have been to design a pen system having accelerometers thereon to monitor the movement of the tip of the pen (column 3, lines 38-43, figure 3 at 20).

However, Fujiwara and Brooks do not teach explicitly bluetooth specification within his device. On the other hand, Lapstun teaches a pen including a marking device operative to mark a visible path onto a surface, the marking device being electronically controllable to change at least one attribute of the path, the pen including a user interface whereby a user may modify the at least one attribute, and at least one sensor device capable of sensing images including coded

Art Unit: 2675

data (column 20, lines 40-45) wherein bluetooth technology would be employed within a pen device (column 20, lines 3-10).

Thus, it would have obvious to combine Fujiwara, Brooks and Lapstun's inventions because while the combination of Fujiwara and Brooks teach a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39) wherein a processor means in the form of CPU 31 facilitates comparing the acceleration sequences generated by the information input unit 2 by receiving pulses generated by the ball 11 of the information input unit 2, such that the pulses stored in RAM 34 to provide a pattern of a letter wherein this pattern is compared to a set of patterns previously stored in the pattern ROM 32 before they are displayed on LCD 3 (column 3, lines 5-33), Lapstun teaches how a pen device would employ bluetooth technology (column 20, lines 3-10). The motivation for combining these inventions would have been to provide an efficient communication form for the pen device (column 20, lines 3-10).

Response to Arguments

7. Applicant's arguments filed October 6, 2003 have been fully considered but they are not persuasive.

With respect to claims 9-15 and 19-22, applicant argues that Fujiwara does not transmit characters to a second device after a connection is established. However, Fujiwara does transmit characters to a second device after a connection is established. This is accomplished by Fujiwara teaching pattern ROM 32 for storing patterns of numerical and alphabetic letters, a program ROM 33 for storing a program by which a telephone number signal and a station name

Art Unit: 2675

signal of the called party are generated (column 2, lines 46-58, figure 3 at 32-34) wherein Fujiwara teaches a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39).

Furthermore, applicant argues that Fujiwara does not have all of the transcription and translation functions of applicant's invention. However, Applicant seems to have ignored the teaching of Brooks wherein Brooks teaches an acceleration sensor 20 within a system for creating artful expressions, including handwritten messages, drawings and other dexterously produced forms which comprises a marking implement having a self contained means of recording the creation wherein the writing implement comprises (column 1, lines 53-61; column 3, lines 30-43, figures 1-3 at 20). Thus, it would have been obvious to a person of ordinary skill in the art to combine Fujiwara and Brooks because while Fujiwara teaches a transmitting and receiving apparatus 39 that establishes a two-way connection between a calling party and a called party (column 2, lines 60 through column 3, lines 4, figure 3 at 39), Brooks teaches how an acceleration sensor would be included in such a device. The motivation for combining these inventions would have been to design a pen system having accelerometers thereon to monitor the movement of the tip of the pen (column 3, lines 38-43, figure 3 at 20). As such, applicant's contention that none of the references discloses a method for converting stylus movements corresponding to a symbol is not persuasive.

Furthermore, applicant attached an article that he contends discloses a Bluetooth system for establishing a two-way wireless connection. However, no where in paragraph XIV (which was pointed out by applicant as specifying this two-way feature) does this article teach a "two-

way wireless connection.” Moreover, the issue here is whether “the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), **at the time the application was filed**, had possession of the claimed invention.” (*see* 35 U.S.C. 112 (1)). By virtue of the specification filed at the time the application was filed, applicant has failed to show that he had possession of a two-way wireless connection.

Hence, applicant’s arguments are not persuasive.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uchendu O. Anyaso whose telephone number is (703) 306-5934.

Art Unit: 2675

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras, can be reached at (703) 305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:


(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Uchendu O. Anyaso

02/20/2004


CHANH NGUYEN
PRIMARY EXAMINER